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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91189629
Party	Defendant Multi Media Exposure, Inc.
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BORGHESE TRADEMARKS, INC.	:	Opposition Proceeding
	:	No. 91189629
Plaintiff-Opposer,	:	
-- against --	:	Mark: PRINCE LORENZO
	:	BORGHESE'S LA DOLCE
MULTI MEDIA EXPOSURE, INC.,	:	VITA
	:	
Defendant-Applicant.	:	Serial No. 77435171

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APPLICANT'S OPPOSITION TO
OPPOSER'S PETITION FOR DISCOVERY PURSUANT TO RULE 56(f)

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INTRODUCTION

Multi Media Exposure, Inc. (“Applicant” or “MME”), applicant for registration on the Principal Register of the trademark PRINCE LORENZO BORGHESE’S LA DOLCE VITA (the “Mark”), hereby opposes the motion of opposer Borghese Trademarks, Inc. (“Opposer”), for discovery pursuant to and F.R.C.P. Rule 56(f).¹ As demonstrated below, Opposer’s petition for discovery should be denied because it fails to demonstrate that discovery would defeat Applicant’s motion for summary judgment.

¹ Opposer’s claim that Applicant improperly refused to answer respond to discovery (see Opposer’s Request for Discovery Pursuant to Rule 56(f) dated October 28, 2009 (“Rule 56(f) Memo.”), at 2), has been rejected in the Board’s decision, holding that Applicant’s motion for summary judgment provided a good faith basis for not responding to discovery. See TTAB Decision dated October 28, 2009, at 4.

A. The Applicable Legal Standard

A motion for discovery pursuant to F.R.C.P. Rule 56(f) should be denied when the movant fails to demonstrate that the discovery it seeks would defeat the motion for summary judgment. “One important advantage sought by the rules from the summary judgment procedure is to save the parties and the court the time and cost that may be wasted in pursuit of irrelevant facts by discovery.” New America Shipbuilders, Inc. v. U.S., 871 F.2d 1077, 1081 (Fed. Cir. 1989). As the Federal Circuit also held:

Summary judgment need not be denied merely to satisfy a litigant's speculative hope of finding some evidence that might tend to support a complaint. Further litigation in this case not only would put the parties to unnecessary expense but also, equally important, would be wasteful of judicial resources.

Sweats Fashions, Inc. v. Pannill Knitting Co., 833 F.2d 1560, 1566-67 (Fed. Cir. 1987) (citations omitted).

Rule 56(f) requires that the requested discovery be narrowly tailored to defeat the motion for summary judgment:

Rule 56(f) requires an affiant to ***state reasons*** why he cannot present by affidavit facts essential to justify his opposition to the motion for summary judgment. Keebler's affidavits state no such reasons, as the board recognized in giving as its reason for denial a paraphrase of Rule 56(f). If all one had to do to obtain a grant of a Rule 56(f) motion were to allege possession by movant of “certain information” and “other evidence”, every summary judgment decision would have to be delayed while the non-movant goes fishing in the movant's files.

Keebler Co. v. Murray Bakery Products, 866 F. 2d 1386, 1389 (Fed. Cir. 1989) (original emphasis; affirm Board’s denial of 56(f) motion and granting of summary judgment). In Keebler, the opposer based its motion on opposer’s having had no discovery at all, but the Federal Circuit noted that Rule 56(f) “makes no such distinction”. Id. at 1390. Rather, the Court held, “each request for discovery [must] be adequately supported by a showing of need.” Id. See TBMP § 528.06 (“The request [for discovery under 56(f)]

must be supported by an affidavit showing that the nonmoving party cannot, for the reasons stated, present by affidavit facts essential to justify its opposition to the motion”).

B. Opposer’s Requested Discovery Would Not Defeat the Applicant’s Motion

Opposer fails to demonstrate why any of the discovery specified in its motion is tailored to defeat the motion for summary judgment.² Indeed, none of the Opposer’s requests relate to the controlling issue at hand: whether PRINCE LORENZO BORGHESE’S LA DOLCE VITA is confusingly similar to BORGHESE or PRINCESS MARCELLA BORGHESE. None of Opposer’s demands are tailored to address any of the Federal Circuit’s DuPont factors. Rather, they constitute general discovery, seeking information and documents that are unnecessary, burdensome and irrelevant to the motion for summary judgment. Because such discovery would not be sufficient to defeat Applicant’s motion for summary judgment, the Rule 56(f) motion must be denied.

1. Discovery is Not Required to Determine Channels of Trade

Nothing in Opposer’s petition for discovery addresses a core element of confusing similarity in this case: Where the application or registration does not indicate any limitations on trade channels, the Board must consider the trade channels are those “suitable for *goods of that type*.” Guardian Products Company, Inc. v. Scott Paper Company, 200 U.S.P.Q. 738, 741, 1978 WL 21568 (TTAB 1978). Absent restrictions as to classes of purchasers or trade channels, the Board presumes that the goods recited in a registration “are or can be sold through all of the trade channels that can be utilized *for*

² See Declaration of Moira Selinka, dated October 28, 2009 (“Selinka”), ¶ 14 (specifying the interrogatories, document requests and requests for admission for which Opposer, through its motion, requests responses); see also Rule 56(f) Memo at 6 (same). Opposer’s discovery demands consist of Opposer’s First Set of Requests for Production of Documents and Things to Applicant dated August 27, 2009 (“Doc. Requests”), Opposer’s First Set of Interrogatories to Applicant dated August 27, 2009 (“Interrog.”), and Opposer’s First Set of Requests for Admission to Applicant, dated August 27, 2009 (“Req. to Admit”).

such goods.” Warnaco Inc. v. Adventure Knits, Inc., 210 U.S.P.Q. 307, 315, 1981 WL 40431 (TTAB 1981) (emphasis added). See 7-Eleven Inc. v. Wechsler, 83 U.S.P.Q.2d 1715, 1721 (T.T.A.B. 2007) (pet bowls versus beverage cups); Fort Dodge Labs., Inc. v. Haeussler, 43 C.C.P.A. 999, 1001, 234 F.2d 506, 508, 110 U.S.P.Q. 301 (C.C.P.A. 1956) (“the normal meaning” of multivitamins was “limited to human use”).

Opposer cannot reasonably argue that its “shampoos and conditioners” are unlimited by the normal meaning of those words. Opposer’s registered goods cannot somehow include pet shampoos and conditioners, any more than its registration could also encompass carpet shampoos (which International Class No. 3 also includes), or shampoos for upholstery.³

Rather, Applicant’s proposed pet shampoos and conditioners and Opposer’s goods, including shampoos and conditioners (implicitly for people), are intended to be sold or actually sold in presumptively different trade channels. Opposer admitted that its own goods travel in the normal channels for cosmetics and bath and body products for people: “Opposer’s goods are sold in department stores, spas, drug stores, pharmacies, and over the Internet.” See Applicant’s Motion for Summary Judgment, at Ex. A, No. 10.

Applicant has similarly alleged, through the declaration of its Vice President, that its trade channels are limited to the normal channels for the pet goods identified in the application for PRINCE LORENZO BORGHESE’S LA DOLCE VITA (the “Mark”):

pet stores, on programs dedicated to pets on direct television (such as Home Shopping Network), and through web sites for pet goods. Applicant does not intend to sell its goods in spas (for people), department stores, drug stores, or

³ Opposer also apparently asserts that Applicant’s “*pet* shampoos and conditioners” constitutes a goods and services description that only limits “*one* of the goods” (Selinka ¶ 18). If the Board felt it necessary, Applicant would amend its goods and services to “*pet* shampoos and *pet* conditioners.” However, basic English would indicate that in the present description of goods and service, the adjective “pet” modifies both nouns.

pharmacies.

Declaration of Lorenzo Borghese, dated September 22, 2009 (“Borghese Decl.”), ¶ 3.

Further, discovery would not help to negate the obvious: if Applicant actually sold its pet shampoos and conditioners under the Mark in any “department stores, spas, drug stores, pharmacies, and over the Internet”, Applicant’s goods would be sold in a department or aisle quite separate and apart from the location of Opposer’s cosmetics and bath and body products (for people).

Opposer has not posed any reason for the Board to question Mr. Borghese’s declaration, or to challenge that the goods are sold in different channels of trade. Thus, Opposer does not require discovery to identify “all trade channels” through which Applicant’s goods will be sold under the Mark, as demanded in Interrog. No. 5. For purposes of Rule 56(f), Opposer must demonstrate that Applicant sells its pet shampoos and conditioners in trade channels that are the same as Opposer’s. However, discovery is not needed to address this issue, because the goods are presumed to travel in their normal channels of trade, and Applicant’s declaration in support confirms the same.

As set forth below at pages 8-9, Opposer needs more than a mere suspicion to undermine and rebut the presumption that Applicant sells or intends to sell its pet goods in the normal trade channels for pet goods. Rather, Opposer must show why it requires production of documents in connection with trade channels – including each “business plan and a copy of each marketing plan” for Applicant’s proposed goods, and documents that identify every wholesaler, etc., that has agreed to sell goods bearing the mark at issue, as demanded in Doc. Request Nos. 8 and 9. Opposer has not shown why such demands are necessary to address the motion for summary judgment.

Similarly, Opposer does not indicate why, for any purpose narrowly tailored to address the motion for summary judgment, it needs information and documents relating to Applicant's intended distributors, wholesalers, et al. (Interrog. No. 4, Doc. Request No. 9) or the broad demand for "all communications" with Applicant's intended manufacturers (Doc. Request No. 11).

Thus, discovery is not necessary to confirm that these are the channels of trade "suitable for goods of [those types]" of goods specified in the respective application and registration. Moreover, Opposer has not demonstrated that its requested discovery would reveal anything that would defeat Applicant's motion for summary judgment.

2. Other Areas of Proposed Discovery Are Irrelevant

PRINCE LORENZO BORGHESE'S LA DOLCE VITA clearly looks and sounds different from BORGHESE and PRINCESS MARCELLA BORGHESE. Notably, none of Opposer's proposed discovery relates to the Board's ability to determine that the marks are substantively different in sound and appearance. Indeed, the Board does not require any further evidence to make such determination.

Opposer's demands for the ingredients in Applicant's goods are overreaching, and irrelevant to opposing the motion for summary judgment.⁴ Such demands do not address whether the trademarks are confusingly similar. Neither party has alleged any particular source (geographic or otherwise) of ingredients of the different products. Moreover, even if some of the ingredients were identical, the discovery necessary to determine the same would be irrelevant to the issue of whether the trademarks attached to the finally-mixed products are confusingly similar. (Further, regardless of the ingredients, the goods

⁴ "Identify[ing] the facility where Applicant's Goods are ... intended to be produced" (Interrog. No. 10) and demanding that Applicant admit whether its goods are being "formulated in a human cosmetics factory" (Req. Admit No. 24). See also Selinka ¶ 14.

consist of end products, created by different methods and in different proportions of their various ingredients; their sums are greater than their parts.)

These demands and others are nothing more than expensive and unnecessary “fishing expeditions.” The purported “use of Opposer’s trademark” on “Applicant’s web site” (Selinka ¶ 14, Req. Admit Nos. 18-21) is simply not at issue. Opposer cannot establish that Applicant’s Mark appears on these websites; clearly, that could be demonstrated by publicly available information, if it existed, rather than discovery. Rather, statements allegedly made on www.getroyaltreatment.com (Req. Admit. Nos. 16, 22, 23), even if deemed to refer to Applicant’s website, www.multimediaexposure.com, relate to Applicant’s purported identification of “Princess Marcella Borghese”. Indisputably, Marcella Borghese was Applicant’s Vice President’s grandmother. See Answer to Notice of Opposition at ¶ 40. However, any identification of Mr. Borghese’s grandmother simply does not relate to whether the marks are confusingly similar, especially absent proof that either of such websites also promoted the Mark at issue here.

Similarly, Opposer’s demands for “copies of all newspaper ... and other articles” referring to the Mark, and “advertisements and/or promotional materials” concerning the goods bearing the Mark (Doc. Request Nos. 2 and 3) are irrelevant to whether the marks are similar. Opposer does not say why such documents would defeat Applicant’s motion.

Likewise, the demands that Applicant’s Vice President admit that he used the name of his grandmother “for publicity purposes” (Req. Admit Nos. 24, 25) are not only unintelligibly vague, but are wholly irrelevant to the central issue of confusing similarity.

3. The Deposition of Applicant’s Vice President Is Unnecessary

Opposer fails to explain precisely why Lorenzo Borghese’s proposed deposition

testimony would preclude summary judgment. The Borghese Declaration is sufficient to demonstrate that, among other things, pet goods to be sold under the Mark are sold, or intended to be sold, in normal trade channels for such goods. See FRCP Rule 56(e)(1) (affidavit requirements). Opposer cannot engage in such a deposition without a specific basis for challenging Mr. Borghese's declaration.

The Board recognizes that declarations are self-serving in nature, and that an opportunity for cross-examination does not normally exist. See TBMP Section 528.05(b). Thus, an opposer does not need to test the credibility of each declarant because, knowing that the declarations are self-serving, the Board can accord them the appropriate probative value. Nevertheless, a declaration submitted in a proceeding that is "internally consistent, not characterized by uncertainty and unchallenged" by the opposing party is sufficient to provide a basis for granting summary judgment, even if the declaration is not accompanied by documentary evidence. Hornblower & Weeks Inc. v. Hornblower & Weeks Inc., 60 USPQ2d 1733, 1736, 2001 WL 1512024 * 4 (TTAB 2001). See 4U Company of America, Inc. v. Naas Foods, Inc., 175 USPQ 251, 253 (TTAB 1972) (absent any credibility issues about affiant's statements, which were competent and uncontradicted, suspicion alone was insufficient to invalidate the affidavit).

The Borghese Declaration is internally consistent, not characterized by uncertainty and presently unchallenged by Opposer. As such, Opposer's mere suspicion and desire to undermine Mr. Borghese's veracity is not sufficient to require his deposition or to prevent the Board from granting Applicant's motion for summary judgment.

C. Because Opposer's Petition for Discovery Also Includes Its Opposition to Summary Judgment, Opposer Has Waived Any Right to Request Discovery

Opposer's petition is not limited to requesting discovery pursuant to Rule 56(f),

but also includes opposition to Applicant's motion for summary judgment. Opposer alleges that "Applicant's declaration makes it clear that there are facts in dispute (which in and of itself should defeat the summary judgment motion." Selinka ¶ 16. However, to the extent a party seeks discovery under Fed. R. Civ. P. 56(f), the motion is rendered moot if that party has responded to the motion for summary judgment on its merits. "Inasmuch as opposer has submitted a substantive response to applicant's motion for summary judgment, opposer's request for discovery pursuant to Fed. R. Civ. P. 56(f) is denied." Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc., 63 U.S.P.Q.2d 2009, 2002 WL 745591, * 6, fn. 8 (TTAB 2002). See also Zodiac Spirits, Inc. v. Anil Mezini Anil Mezini v. Koan, Inc. 2008 WL 885884, * 1 (TTAB 2008; not precedential); Missiontrek Ltd. Co. v. Onfolio, Inc., 80 U.S.P.Q.2d 1381, 2005 WL 3395187. * 5, fn. 6 (TTAB 2005; not precedential). For this additional reason, the motion for discovery should be denied, and summary judgment should be granted.

CONCLUSION

For the foregoing reasons, Applicant Multi Media Exposure, Inc. respectfully requests that the Board deny the Rule 56(f) motion of Opposer Borghese Trademarks, Inc., grant summary judgment to Applicant and dismiss the opposition in its entirety.

Dated: New York, New York
November 17, 2009



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DECLARATION OF SERVICE

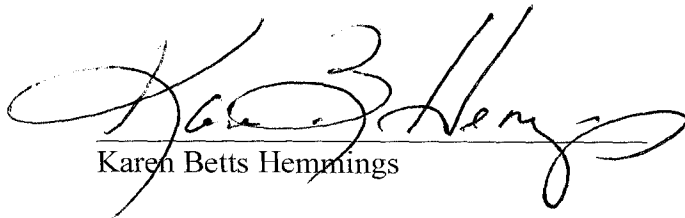
Karen Betts Hemmings declares the following to be true under the penalties of perjury of the laws of the United States of America:

That on the 17th day of November, 2009, declarant served the within APPLICANT'S OPPOSITION TO OPPOSER'S MOTION FOR DISCOVERY PURSUANT TO RULE 56(f) upon

Moira J. Selinka, Esq.
Baker and Rannells, P.A.
575 Route 28, Suite 102
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attorneys for BORGHESE TRADEMARKS, INC., plaintiff-opposer in the above-captioned lawsuit, at the addresses designated by said attorneys for such purpose, by causing the same to be served by depositing a true copy of same enclosed in a postage paid properly addressed wrapper, in an official depository under the exclusive care and custody of the U.S. Postal Service within the State of New York.

Dated: New York, New York
November 17, 2009


Karen Betts Hemmings